

REMARKS

Claims 1, 31, 34, 36 and 38 are currently amended. Reconsideration of the application in view of the above amendments and the following remarks is requested.

I. The Rejection of Claims 1-16, 18-20 and 27-39 under 35 U.S.C. 112, 1st ¶

Claims 1-16, 18-20 and 27-39 stand rejected as failing to comply with the written description requirement in that the Applicants allegedly did not have possession of the claimed invention. The Examiner contends that Applicants fail to provide basis for the claims as set forth wherein the particulate materials are water soluble and water is the liquid.

Applicants traverse this rejection.

Section 112, first paragraph provides that:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same....

The written description requirement of 35 U.S.C. § 112, first paragraph, is fulfilled when the patent specification describes the claimed invention in sufficient detail such that the claim limitations are described so that one of skill in the art would recognize that the applicants had invented the subject matter. See *Vas-Cath, Inc. v. Mahurkar*, 19 U.S.P.Q.2d 1111, 1116 (Fed. Cir. 1991); *In re Herschler*, 591 F.2d 693, 700 (C.C.P.A. 1979). The written description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. See *In re Marzocchi*, 169 U.S.P.Q. 367 (CCPA 1971).

Any assertion by the USPTO that water soluble particulate starting material is not described in the specification or in possession of Applicants is clearly inaccurate. In fact, water soluble particulate starting material was specifically identified in the patent specification. For example, the specification, *inter alia*, at page 2, lines 18-19 provides basis for water soluble particles. More specifically the specification states "Furthermore the particles are readily dispersible or soluble in water, preferably fully soluble in water." See page 2, lines 18-19.

Importantly, the specification at page 5 provides:

For many particles it is desirable that the particles are readily dispersible or soluble in water and often it is desired to have fully soluble particles, e.g. enzymes particles and inert particles used as carrier materials or seeds which are often used in products where it is desirable that the product is readily dispersible or soluble in water and often fully soluble. **Therefore it may be important that the materials used to produce said particles are readily dispersible or soluble in water and preferably fully soluble in water.** We have found that the present invention is a very cost effective way of preparing water soluble inert particles with higher particle strength than compared to ordinary non-pareil seeds.

Further, under the section "Particulate starting materials" the specification clearly states: "In a particular embodiment of the present invention the particulate material is water soluble." See page 8, line 10.

Moreover, as illustrated in Example 1, 5000g of water is added to make the mixture therein.

Finally, original claim 17 required "particulate material is water soluble."

Notwithstanding the above, the Examiner has not provided sufficient evidence or reasoning to rebut that the specification provides an adequate written description for water soluble particulate materials where water is the liquid. In this regard, additional representative examples are not required to be disclosed.

Therefore, Applicants respectfully submit that the specification contains a sufficient description of the water soluble particulate starting materials to fulfill the requirements of 35 U.S.C. 112. Reconsideration and withdrawal of the rejection are therefore respectfully requested.

II: The Rejection of Claims 1-16, 18-20 and 27-39 as Anticipated/Obvious.

Claims 1-16, 18-20 and 27-39 stand rejected under 35 U.S.C. 102(b) as being anticipated by or obvious under 35 U.S.C. 103(a) by Guraya (U.S. Patent No. 6,737,099 herein after referred to simply as "Guraya I"). Independent claims 1, 31, 34, 36 and 38 are currently amended to require that the starting material be fully water soluble. This limitation is not new and is based on the specification as cited above. Claim 1, as currently amended, requires, *inter alia*, fully water soluble particulate starting material. In other words, the starting material is fully soluble in water. Conversely, Guraya relates to flour from milled seed of cereals. The Guraya reference does not disclose using soluble

particles; nor does it suggest applying the Guraya treatment to anything fully soluble in water. Flour is not fully soluble in water. For example, Guraya claims and refers to "aqueous slurry of an amylaceous flour". In Guraya, a slurry is formed because the flour does not go into solutions and is not fully water soluble. Accordingly, independent claims 1, 31, 34, 36 and 38 referring to fully water soluble starting materials are not anticipated by Guraya. Reconsideration is urged.

Applicants note that Guraya does not make claims 1, 31, 34, 36 and 38 obvious.

The Guraya reference does not disclose using fully soluble particles; nor does it suggest applying the Guraya treatment to fully soluble particles.

Obviousness is a question of law based on underlying findings of fact. An analysis of obviousness must be based on several factual inquiries: (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; (3) the level of ordinary skill in the art at the time the invention was made; and (4) objective evidence of nonobviousness, if any. See Graham v. John Deere Co., 383 U.S. 1, 17-18 (1966). The teachings of a prior art reference are underlying factual questions in the obviousness inquiry. See Para-Ordnance Mfg., Inc. v. SGS Imp. Int'l, Inc., 73 F.3d 1085, 1088 (Fed. Cir. 1995). "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 at 418, 82 USPQ2d at 1396 quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). "A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. at 418, (2007). To find obviousness, the Examiner must "identify a reason that would have prompted a person of ordinary skill in the art in the relevant field to combine the elements in the way the claimed new invention does." *Id.* 35 U.S.C. 103(a) bars patentability unless "the improvement is more than the predictable use of prior art elements according to their established functions." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. at 417.

As explained above, Guraya fails to show each and every element of the present disclosure. Further any attempt by the Examiner to argue that Guraya makes independent claims 1, 31, 34, 36 and 38 obvious would erroneously retrace the path of the inventor with hindsight —discounting the number of complexities of the alternatives in order to conclude that the specifically claimed method was obvious. This reasoning is always inappropriate

for an obviousness test based on the language of Title 35 that requires the analysis to examine "the subject matter as a whole" to ascertain if it "would have been obvious at the time the invention was made." 35 U.S.C. § 103(a).

Even applying a non-rigid TSM analysis, one of ordinary skill in the art would not be motivated by Guraya to modify the flour of Guraya and change it to a fully water soluble component and mix it with a liquid as in the present disclosure. None of the independent claims are obvious. Reconsideration is urged.

III: The Second Obviousness Rejection of Claims 1-16, 18-20 and 27-39

Claims 1-16, 18-20 and 27-39 stand rejected under 35 U.S.C. 102(a) as being anticipated by or obvious under 35 U.S.C. 103(a) by Guraya II (WO 02/078457 herein after referred to simply as "Guraya II"). Independent claims 1, 31, 34, 36 and 38 are currently amended to require that the starting material be fully water soluble.

Reconsideration is urged based on the arguments in section II above. No claim is obvious.

IV Conclusion

In view of the above, it is respectfully submitted that all claims are in condition for allowance. Early action to that end is respectfully requested. The Examiner is hereby invited to contact the undersigned by telephone if there are any questions concerning this amendment or application.

Should any additional fees be due the USPTO is authorized to charge the deposit account of Novozymes North America, Inc, i.e., Deposit Account No. 50-1701.

Respectfully submitted,

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